

REMARKS/ARGUMENTS

Allowance of all pending claims (claims 1, 3-17, 19-30, 33-44, 47-53, 55-60, 75, 76, 78, 80-87 and 103-150) was withdrawn by the Examiner and claims 1, 3-17, 19-30, 33-41, 44, 47-50, 53, 75, 76, 80-87 and 103-150 were newly rejected. Claims 143-150 were allowed and claims 42, 51-52 were objected to. Reconsideration of the claims is requested.

Claims 1, 3-5, were rejected under 35 U.S.C. 102(e) as being anticipated by Castaneda et al. (6,464,691). The Examiner states that Castaneda et al discloses a tissue stabilizer having first and second toe portions rotatably adapted for insertion into an endoscope.

Applicants disagree that Castaneda et al. '691 anticipate **claim 1**. To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make or carry out the claimed invention without undue experimentation. See *Elan Pharm., Inc. v. Mayo Foundation for Medical and Education Research*, 346 F.3d 1051, 68 USPQ2d 1373 (Fed. Cir. 2003). Among other elements, Castaneda et al. '691 do not disclose each toe portion comprising at least one suction port to apply suction to the target tissue during stabilization as described in claim 1 of the instant application. Therefore, not every element of the challenged claim is disclosed by the anticipatory reference. In addition, the only mention that Applicants find of suction in Castaneda et al. '691 is in the phrase, "the feet may apply suction" (col.3, line 18). There is ***no enabling disclosure***, including descriptive text and/or figures, which could indicate or teach in any way one of ordinary skill in the art to make the anticipating subject matter. It is unclear as to how the Castaneda et al. '691 device could be equipped to apply suction and, moreover, how at least one suction port to apply suction for each toe portion could be incorporated into the Castaneda et al. '691 device. Therefore, for at least these reasons, Applicants believe **claim 1** is allowable, along with dependent **claims 3-5**.

Claims 6-17, 19-41, 43-44, 47-50, 53, 55-60, 75-76, 78, 80-87, 103-142 were rejected under 35 U.S.C. 103(a) as being unpatentable over Castaneda et al. in view of Boone et al (6,740,028).

Claim 6 depends from claim 1 which has been differentiated from Castaneda et al. '691 as stated above. Although Boone et al. '028 describes a suction port 33 open along the

bottom surface of a suction pod 22, it is unclear how the suction ports 33 could be used with the Castaneda et al. '691 device. The Boone et al. '028 device is designed to be clamped to a wide variety of commonly used sternal retractors (col. 7, lines 37-38) and used during open chest procedures. The Boone et al. '028 device is not designed to be insertable through an endoscopic cannula and therefore it is not apparent that the elements provided by Boone et al. '028 may be transferred to the Castaneda et al. '691 device for at least the reasons of size limitations. In addition, suction is described and illustrated in the Boone et al. '028 device to be applied to the suction pods 22 by barbed connections 325 at the proximal end of the suction pods 22. If such barbed connections 325 (or any such connections) were applied to the proximal ends of the stabilizing feet 428, 430 of Castaneda et al. '691 to provide suction to supposed suction ports thereon, such connections would interfere with the described functions of the stabilizing feet 428, 430 of Castaneda et al. '691. Castaneda et al. '691 describes and illustrates the stabilizing feet 428, 430 rotating so that contact surfaces 568, 568' of the feet 428, 430 contact each other, as illustrated in Fig. 24. This position is required for advancing the feet 428, 430 through the port device 10. It is unclear how barbed connections 325 could be present at the proximal ends of the stabilizing feet 428, 430 without interfering with upper arms 450, 452 and lower arms 454, 456 when rotating so that contact surfaces 568, 568' of the feet 428, 430 contact each other. For at least these reasons, Applicants believe that claim 6 is differentiated from the combination of Castaneda et al. '691 and Boone et al. '028. Therefore, discussion of any teachings provided by Boone et al. '028 to provide further elements claimed in claim 6 of the instant application are now moot in point. Applicants believe claim 6 is allowable along with **claims 7-16** which also depend from claim 1.

Claim 17 also includes description of each toe portion comprising at least one suction port to apply suction to the target tissue during stabilization, as included in claim 1 of the instant application. Therefore, Applicants believe that claim 17 is differentiated from the combination of Castaneda et al. '691 and Boone et al. '028 for the reasons stated above in relation to claim 1, along with **claims 19-29** which depend therefrom.

Claim 30 also includes description of each toe portion comprising at least one suction port to apply suction to the target tissue during stabilization, as included in claim 1 of the

instant application. Therefore, Applicants believe that claim 30 is differentiated from the combination of Castaneda et al. '691 and Boone et al. '028 for the reasons stated above in relation to claim 1, along with **claims 33-41** which depend therefrom.

Claim 43 includes description of each toe portion comprising at least one suction port and applying suction to the target tissue through the at least one suction port to stabilize the target tissue. Therefore, Applicants believe that claim 43 is differentiated from the combination of Castaneda et al. '691 and Boone et al. '028 for the reasons stated above in relation to claim 1, along with **claims 44, 47-50** which depend therefrom.

Claim 53 includes description of each toe portion comprising at least one suction port and applying suction to the target tissue through the at least one suction port to stabilize the target tissue. Therefore, Applicants believe that claim 53 is differentiated from the combination of Castaneda et al. '691 and Boone et al. '028 for the reasons stated above in relation to claim 1, along with **claims 55-60** which depend therefrom.

Claim 75 includes description of the first toe arrangement configured so that the first toe portion lies overlapping at least a portion of the second toe portion. Applicants find no description in Castaneda et al. '691 or Boone et al. '028 of such overlapping. In Castaneda et al. describes rotating stabilizing feet 428, 430 so that contact surfaces 568, 568' of the feet 428, 430 contact each other. Boone et al. '028 illustrates a variety of arrangements of the suction pods in Figs. 23-29, none of which include overlapping. Therefore, for at least these reasons, Applicants believe claim 75 is allowable along with **claims 76, 78, 80-87** which depend therefrom.

Claim 103-142 were newly added claims in the last Amendment, mailed June 10, 2004. These claims were objected to claims rewritten in independent form with claims depending therefrom. Therefore, each of these claims includes elements present in the above mentioned claims which have been differentiated from Castaneda et al. '691 and Boone et al. '028 for the reasons stated above. Therefore, Applicants believe **claims 103-142** are allowable.

THE ADDED CLAIMS

Claims 151-154 have been added to more fully describe the invention. No new matter has been added.

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Reply to Office Action of 11/17/2004


PATENT

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,


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